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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/518,870      | 08/29/2005  | Masayoshi Shichiri   | 4439-4028           | 5652             |

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NEW YORK, NY 10281-2101

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| EXAMINER |
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PAGONAKIS, ANNA

|          |              |
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| ART UNIT | PAPER NUMBER |
|----------|--------------|

1614

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|-------------------|---------------|
| NOTIFICATION DATE | DELIVERY MODE |
|-------------------|---------------|

06/27/2008

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PTOPatentCommunications@Morganfinnegan.com

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### Office Action Summary

**Application No.**

10/518,870

**Applicant(s)**

SHICHIRI ET AL.

**Examiner**

ANNA PAGONAKIS

**Art Unit**

1614

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-23 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/86)  
Paper No(s)/Mail Date \_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_

#### **DETAILED ACTION**

Due to the complex nature of the claims, no request for oral election is being made. Please see MPEP 812.01.

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

"Use" claims 8-9 are being reasonably interpreted as either a composition, or, a method and therefore claims 8-9 will be included in both composition and method Groups as a result of those different interpretations.

Claims 1-23 are subject to this restriction requirement.

#### **Lack of Unity – Two Groups**

Group I, Claims 9-11, 23, drawn to a method for screening an angiogenesis-inhibiting substances wherein a test substance is added to cultured vascular endothelial cells, and an angiogenesis- inhibiting signal based on gene expression level is detected, class 514, subclass 183.

Group II, claim(s) Claims 1-8, 12-22, drawn to an angiogenesis inhibitor containing an ansamycin antibiotic or a pharmacologically acceptable derivative thereof as an active ingredient, class 514, subclass 183.

Groups I and II do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical feature for the following reasons: an ansamycin antibiotic is known as chemotherapeutic agents (see US Patent 6,670,348 to Rosen et al., abstract). Therefore, a holding of lack of unity amongst the inventions of Groups I and II is proper.

#### **Election of Species Requirement**

Applicant is reminded under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Specifically with the election of Groups I and II, applicant is required to elect one ansamycin antibiotic (see instant claims 1-2, 12). Additionally, applicant must elect one form of angiogenesis (see instant claims 4-5, 7, 16-17) and one condition (see instant claims 4-8, 13-22). If applicant elects a specie from the above specie election which is not found in the instant disclosure as filed, specie election may be considered new matter. Additionally, applicant is required to provide a chemical structure of the elected compound as well as to specify precisely where the elected compound can be found in the instant disclosure.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non responsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant is entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must include which are readable upon the elected species. See MPEP 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

#### **Election/Restriction Proper**

Each compound and therapeutic agent has a totally different structure and thus different reactivity, binding affinity, Mechanism, stability, polarity, bioavailability, efficacy, solubility and modes of action. Also, the search for one specie will not lead to information regarding another, and vice versa. Furthermore, each disease has a different and distinct etiology and pathophysiological manifestations, and that each is differently treated. Such is sufficient to indicate that each of the methods and compositions of treating the presently claimed disease states is differently searched in the patent and non-patent literature and that a search for one disease will not necessarily result in a comprehensive search of any one or more of the other diseases listed. As a result, an undue burden would be placed on the Examiner to search each of Applicant's presently claimed methods. Notwithstanding that Applicant may have established an underlying commonality for the claimed diseases, it remains that each of the diseases are recognized in

the art as being clinically and pathologically distinct from one another and, thus, each of the above-identified groups is fully capable of supporting separate patents.

Additionally, each disease has a different and distinct etiology and pathophysiological manifestations, and that each is differently treated. Such is sufficient to indicate that each of the methods of treating the presently claimed disease states is differently searched in the patent and non-patent literature and that a search for one disease will not necessarily result in a comprehensive search of any one or more of the other diseases listed. As a result, an undue burden would be placed on the Examiner to search each of Applicant's presently claimed species. MPEP 809.02(d) states "[w]here only generic claims are presented, no restriction can be required except in those applications where the generic claims recite such a multiplicity of species that an unduly extensive and burdensome search would be necessary if all the claimed species were to be examined simultaneously.

The inventions above are patentably distinct. The search for each of the above inventions is not co-extensive particularly with regard to the literature search. Burden consists not only of specific searching of classes and subclasses, but also of searching multiple databases for foreign references and literature searches. Burden also resides in the examination of independent claim sets for clarity, enablement and double patenting issues. Further, a reference that would anticipate the invention of one group would not necessarily anticipate or even make obvious the other group. Finally, the consideration for patentability is different in each case. Thus, it would be undue burden to examine all of the above inventions in one application and the restriction for examination purposes as indicated above is deemed proper.

#### **Inventorship Notice**

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

#### **Notice of Possible Rejoinder**

The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product will be considered for rejoinder. All claims directed to a nonelected process invention must require all the limitations of an allowable product claim for the process invention to be rejoined.

In the event of rejoinder, the requirement for restriction between the product claim and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all the criteria for patentability including the requirements of 35 U.S.C. 101, 112, 103 and 112. Until all claims to be elected product are found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims not commensurate in scope with allowable product will not be rejoined. See MPEP 841.06(b). Additionally, in order to retain the right to rejoinder in accordance with the above policy, applicant is advised that the process claims should be amended during prosecution to require the limitations of the product claims. Failure to do so may result in a loss of the right to rejoinder. Further, note that the prohibition against double patenting

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rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP 804.01.

### **Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ANNA PAGONAKIS whose telephone number is (571)270-3505. The examiner can normally be reached on Monday thru Thursday, 9am to 5pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ardin H. Marschel can be reached on 571-272-0718. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AP

/Ardin Marschel/  
Supervisory Patent Examiner, Art Unit 1614